

REMARKS

Upon entry of the above amendment, claims 66-77 will be pending in this application. New claims 65-78 are fully supported by the original claims and the specification at, for example, page 62. Although Applicants respectfully disagree with the Office Action's rejection of claims 37, 39-49, 51-53, 55-59, 61 and 63-65, Applicants have canceled these claims for the sole purpose of compact prosecution. Further, Applicants reserve the right to resubmit the canceled claims at a later time.

Applicants acknowledge the Office Action's rejection of the pending claims for alleged nonstatutory double patenting over copending Application No. 09/315,581. As this rejection is provisional in nature, Applicants will address this issue in a subsequent response upon indication of otherwise allowable subject matter in the present application or in the 581 application.

The Office Action's rejection of claims 37, 42, 44-49, 51, 55-58, 61, 63 and 65 under 35 U.S.C. §112, first and second paragraph, is rendered moot by the cancellation of these claims.

The Office Action's rejection of claims 37, 42, 44-49, 51, 55-58 and 61 for alleged anticipation under 35 U.S.C. 102 (e) by U.S. Patent No. 5,858,784 to Debs et al. (hereinafter "the 784 Patent") is rendered moot by the cancellation of these claims. Also, Applicants respectfully assert that the 784 Patent cannot anticipate the new claims because it does not disclose all the elements of the claims. For example, one of the elements of claim 66 is that the sugar moiety of at least one nucleoside unit of the oligonucleotide is a 2'-O-substituted nucleoside unit.

Although the 784 Patent reports that an antisense oligonucleotides may be aerosolized to be delivered to the lung, the 784 Patent is silent with respect to the specific features of the antisense oligonucleotides. Accordingly, the 784 Patent cannot anticipate the pending claims because it does not teach all the elements thereof. If the Office continues to insist that the 784 Patent teaches the antisense oligonucleotides of the

present claims, Applicants respectfully request that the Office identifies the specific location in the 784 Patent where the oligonucleotide of the present invention is taught.

The Office Action's rejection of claims 37, 42, 44-49, 51, 55-58 and 61 for alleged anticipation under 35 U.S.C. 102 (e) by U.S. Patent No. 6,468,798 to Debs et al. (hereinafter "the 798 Patent") is rendered moot by the cancellation of these claims. Also, Applicants respectfully assert that the 798 Patent cannot anticipate the new claims because it does not disclose all the elements of the claims. For example, one of the elements of claim 66 is that the sugar moiety of at least one nucleoside unit of the oligonucleotide is a 2'-O-substituted nucleoside unit.

Although the 798 Patent reports that an antisense oligonucleotides may be aerosolized to be delivered to the lung, the 798 Patent is silent with respect to the specific features of the antisense oligonucleotides. Accordingly, the 798 Patent cannot anticipate the new claims because it does not teach all the elements thereof. If the Office continues to insist that the 798 Patent teaches the antisense oligonucleotides of the present claims, Applicants respectfully request that the Office identifies the specific location in the 798 Patent where the oligonucleotide of the present invention is taught.

The Office Action's rejection of claim 63 for alleged obviousness under 35 U.S.C. 103 (a) over the 798 Patent in view of U.S. Patent No. 5,514,788 to Bennett (hereinafter "the 788 Patent") is rendered moot by the cancellation of claim 63. Also, Applicants respectfully assert that the 798 Patent does not disclose or teach all the elements of the new claims. For example, one of the elements of claim 66 is that the sugar moiety of at least one nucleoside unit of the oligonucleotide is a 2'-O-substituted nucleoside unit.

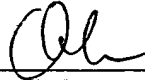
The 788 Patent, alone or in combination with the 798 Patent, does not cure this deficiency, and in fact, the 788 Patent is devoid of any disclosure or teaching of aerosolized compounds. Therefore, the combination of the cited art neither discloses nor suggests the presently claimed invention. Accordingly, Applicants respectfully request reconsideration and withdrawal of this rejection.

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PATENT

Applicants submit that pending claims are in condition for allowance, and an early Office Action to that effect is earnestly solicited.

Respectfully submitted,



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